

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit: 3751
)	
BALL)	Examiner: Robert M. Fetsuga
)	
Serial No.: 10/732,726)	Confirmation No.: 2017
)	
Filed: December 10, 2003)	Appeal No.: 2007-0769
)	
Atty. File No.: 5564-152)	<u>REPLY BRIEF</u>
)	
For: "Method and Apparatus for Assembling and Sealing Bathtub Overflow and Waste Water Ports"		<i>Electronically Filed</i>

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

Appellant submits this Reply Brief pursuant to 37 CFR §§ 41.39(b)(2) & 41.41 in response to a Supplemental Examiner's Answer dated January 30, 2008. No fees are believed to for this submission. The Commissioner, however, is authorized to debit Deposit Account 19-1970 if required.

Withdraw of the new grounds of rejection is requested in view of the arguments provided herein.

Status of the Claims begin on page 2 of this paper;

Grounds of the Rejection to be Reviewed on Appeal begin on page 3 of this paper; and

Arguments begin on page 4 of this paper.

STATUS OF THE CLAIMS

Presently, Claims 1, 5-8 and 10 are pending in the instant application. Claims 7 and 8 have been withdrawn. In a Decision dated October 17, 2007, the BPAI affirmed the Examiner's rejection of Claims 1, 5 and 6. The BPAI, however, reversed the Examiner's rejection of Claim 10. Claim 10 has been rejected under new grounds in a Supplemental Examiner's Answer dated January 30, 2008. The rejection of Claim 10 is now the subject of the Appeal.

GROUND OF THE REJECTION TO BE REVIEWED ON APPEAL

The Examiner has rejected Claim 10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2002/0032926 to Lewis ("Lewis"), U.S. Patent No. 5,890,241 to Ball ("Ball") and U.S. Patent No. 6,618,875 to Oropallo et al. ("Oropallo").

ARGUMENTS

The Board of Patent Appeals and Interferences (BPAI) reversed the Examiner's holding that Claim 10 was obvious in view of a combination of Lewis, Fritz, and Oropallo. Thereafter, the application was remanded to the Examiner for further consideration of the prior art. The Examiner issued a Supplemental Examiner's Answer wherein Claim 10 was rejected as being obvious under new grounds - a combination Lewis, Ball and Oropallo. The Examiner has asserted that Lewis discloses a majority of the claimed subject matter, Ball was cited for disclosing the claimed diaphragm, and Oropallo was cited for employing the claimed combination of a nut and a cap. Claim 10 reads:

10. A method for conducting a fluid leakage test on a fluid system comprising a bathtub which has a bottom and adjacent side and end wall, and an overflow port in an end wall, and with the overflow port being in communication with a primary drain system steps comprising:

providing a one-piece overflow fitting have an overflow pipe with an upper end portion and a lower end portion, the upper end portion having an outer end defining an inlet being adapted to fit through the bathtub overflow port;

providing threads on an outer surface of the upper end portion and surrounding the inlet and normally extending through the bathtub overflow port;

providing a lip extending radially outwardly from an outer surface of the overflow pipe between the elbow portion and the upper end portion and being spaced from the inlet to engage an outer surface of the bathtub end wall around the bathtub overflow port;

sealing a thin diaphragm to the outer end of the upper end portion to close the inlet to fluid flow;

opening the diaphragm to permit the flow of fluid through the overflow port;

threading a nut element compatible with the threads wherein the nut element has a threaded portion for threadably mounting the nut to the upper end portion to

clamp the overflow fitting to the end of the bathtub between the lip and the nut element, and at least one lug extending radially from the nut; and detachably engaging a cap to the lug to cover the nut.

Again, Lewis was cited for disclosing all of the claim limitations "except for the overflow fitting including a diaphragm and cap." Ball was cited for the notion of providing a diaphragm. Oropallo was cited for supplying an overflow fitting having a cap. Appellant asserts that Oropallo does not qualify as prior art under 35 U.S.C. §102 and can not be combined with Ball and Lewis under 35 U.S.C. §103.

More specifically, review of the record will show that the instant application is a Continuation-In-Part of U.S. Patent Application Serial Nos. 09/954,420, filed September 17, 2001, now U.S. Patent No. 6,691,411 and 10/229,533, filed August 28, 2002, now U.S. Patent No. 6,675,406, the latter being a Continuation of abandoned U.S. Patent Application No. 09/593,724 ("the '724 application"), filed June 13, 2000. Thus subject matter of the '724 application commonly disclosed in the manner provided by the first paragraph of 35 U.S.C. §112 in the instant application enjoys a priority date of June 13, 2000. 37 C.F.R. 1.78. Oropallo was filed March 28, 2002 after the filing date of the '724 application. The cap and nut combination, for which Oropallo was cited as disclosing, was disclosed at least in Fig. 3 of the '724 application, and, thus, has the benefit of the June 13, 2000 filing date. Accordingly, withdrawal of rejection to Claim 10 is respectfully requested since Oropallo does not qualify as prior art.

Based upon the foregoing, Appellant believes that Claim 10 is in condition for allowance and such disposition is respectfully requested.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: /C.W.Mueller/

Craig W. Mueller
Registration No. 52,055
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

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